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EXAMINER

CHUMPITAZ, BOB R

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/751,011	<b>Applicant(s)</b> LEON ET AL.	
	<b>Examiner</b> BOB CHUMPITAZ	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 5/20/2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-12 and 14-24 is/are pending in the application.
- 4a) Of the above claim(s) 4, 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-12 and 14-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This communication is a Final Office Action in response to application filed May 20, 2009. Claims 1, 5-12 and 14-24 have been amended, claims 4 and 13 have been cancelled, claims 2 and 3 were previously presented, therefore claims 1-3, 5-12 and 14-24 are pending and addressed below.

#### ***Response to Amendments***

In light of Applicant's cancellation of claims 4 and 13, the claim objection to claims 4 and 13 are now moot.

The Examiner withdraws the previous 35 U.S.C. 112 2<sup>nd</sup> rejections to claims 20-23.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the **second paragraph** of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 5-9, 14-18 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**Claims 5-9 and 14-18** depend from cancelled claims 4 and 13, therefore claims 5-9 and 14-18 are rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For examination

purposes the Examiner interprets claims 5-9 and 14-18 to depend from claims 1 and 10 respectively, since the previous claims submitted (12/4/08) share similar dependencies.

**Furthermore, Claims 9 and 18** recites the limitation "the related parent position element." Claims 5 and 14, which whom claims 9 and 18 depend from respectively, have been amended to cancel the noted claim limitation: "the related parent position element." Therefore, there is insufficient antecedent basis for this limitation in the claim.

**Claim 24**, recites: "the related parent position element." Therefore claim 24 is also rejected under 112 2<sup>nd</sup> paragraphs for the same reasons claims 9 and 18 are rejected. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-3, 5-9, 10-12 and 14-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mui et al. (US 2003/0229529 A1, hereinafter Mui) in view Kurzius et al. (US 6,385,620 B1, hereinafter Kurzius) and in further view of Peterson (US 7,099,350).**

**As per claims 1 and 10**, Mui discloses a method in a computing system, the method comprising: managing employee data ([0003, 123] manage entities within a business, which includes employees, clients, companies, departments, and business units), and a computer-readable

Art Unit: 3629

storage medium carrying one or more sequences of instructions for managing employee data, wherein execution of the one or more sequences of instructions by *one or more* processors causes the *one or more* processors ([0220, 631, 1205] business application platform system, where the general purpose system includes one or more central processing units; CD-ROM medium 219 which typically contains programs 221 and other data) to perform:

wherein the managing comprises:

extracting, using the computing system, employee position management information in a first form that is associated with a first source computerized employee position management system ([0871-873] documents to be exchanged are defined, then XSL style sheets convert interchange format to the system specific XML format and vice versa; see also [0880] extracting the required object based on the information passed in local object; [0170, 1209] the SABA interconnect backplane can access the new employee data via XML; see also [0857-858] accessor 935 and importer 940; see also Claim 19: job position profile record representing the person's job position, wherein the job position profile record identifies required competencies and associated required competency level);

converting, using the computing system, the employee position management information in the first form into employee position management information that is in a second intermediate form ([0871-873] documents to be exchanged are defined, then XSL style sheets convert interchange format to the system specific

XML format and vice versa; see also [0880] transforming the object into a serialized representation which is an XML document; [1209] employee data via XML, the interconnect server performs style sheet transformation to convert the XML into the platform's native format and transmit the data to the business server which then updates the database management system; see also, [0737] the role of the view style is to convert the XML document to a format document understood by the user agent; see also [0857, 0893] the accessor 935 is used to extract objects from the source representation and convert them to a interchange format);

Mui does not expressly disclose;

“wherein the second intermediate form comprises a list of employee position elements for defining a hierarchy of data elements”, “the hierarchy of data elements comprises a plurality of employee position elements” and “the plurality of employee position elements comprises a related parent position element.”

However, Mui discloses establishing a plurality of person records, building a desired goal profile record representing a desired goal to be achieved [0008-9] and where a performance application utilizes created competency records in establishing competencies held by individuals and competencies required to achieve goals ([1247]; see also claim 17). In addition, Kurzius teaches wherein a web server receives candidate qualification data in a form of a candidate profile form. Parsing a particular candidate record may result in determination of

eighteen candidate qualifications related to geography, technical qualifications, etc., and as a result of such parsing, eighteen candidate identifiers will be generated by candidate mapping engine for indexing and listing in map categories of candidate map corresponding to the eighteen candidate qualifications (col. 5, line – col. 7, line 7; see Figs. 5, 14A-14B, 15 and the associated text). In addition Kurzius teaches a filter engine operable to screen candidate profiles entered via a candidate survey form before storing such candidate profiles in candidate records within candidate record database. The candidate qualification data in a profile is evaluated to ascertain whether or not a predefined level of experience or competency is demonstrated by the candidate qualification data (col. 7, line 23 – col. 8, line 26). Kurzius further teaches a candidate matching engine operable to match candidate records to job posting records and wherein specific matching criteria may include required job criteria and preferred job criteria that is designated by an employer (col. 8, lines 27-40). Lastly, Kurzius teaches position titles, education, work history, and any other candidate qualification data can be listed in candidate records (col. 20, lines 41-48), and a job posting form that may be used by an employer to specify desired candidate qualifications for a described employment position (col. 18, lines 54-67 & Fig. 18).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method for enterprise workforce planning disclosed by Mui to include a system and method for the management of

candidate recruiting information as taught by Kurzius in order to effectively identify and evaluate the plurality of employee position elements linked to a parent position element so that the competencies identified in a candidate profile record are compared to the required competencies identified in a position in order to identify the best fit candidates.

The Mui/Kurzius combination does not expressly disclose converting, using the computing system, the employee position management information in the second intermediate form into employee position management information in a target form that corresponds to a target computerized employee position management system.

However, Mui discloses wherein documents to be exchanged are defined, and where XSL style sheets then convert interchange format to the system specific XML format and vice versa [0871-873]. In addition, Peterson teaches a method for transferring information between first and second systems with dissimilar first and second database structures (col. 3, lines 15-29 method includes the step of first extracting data from the first system and then routing the extracted data from the first system to a first conversion server....at the first conversion server data is converted from a format compatible with the first database structure to an intermediate format....the intermediate format is then routed to a second conversion server....at the second conversion server data is converted from the



intermediate format to a format compatible with the second database structure....the data converted at the second conversion server is then stored in the second system). Petersen further teaches where at the first data conversion server, data is converted from a format compatible with the first database structure to an intermediate format, and where the data in the intermediate format is then routed to a second conversion server (second system). The Examiner interprets the second system to represent the target computerized employee position management system. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system and method for managing application processes disclosed by Mui to include the method and system for converting and routing the converted information as taught by Peterson in order to effectively convert and transmit employee position management information into a second intermediate form that corresponds to a target system so that the converted intermediate information may be stored in the target system.

**As per claims 2 and 11,** Mui further discloses the method and computer readable storage medium further comprising using the employee position management information in the target form to perform at least one computer-implemented act from a set of computer-implemented acts and a computer-readable storage medium ([0220] memory section 209, CD-ROM medium 219) comprising:

creating a new employee position management record in the target computerized employee position management system ([0127] profile manager; [0230] the

Art Unit: 3629

persistence framework defines a common code path used to create new objects, restore and update existing objects, delete objects and find objects; [0234] creating a new employee; [1209] new employee is added and Claim 19: job position profile); and

updating an existing employee position management record in the target computerized employee position management system ([0004] constantly updating and advancing the skills and performance of the company's workforce; [0205-208] SABA performance manages profile metadata that describes individual and group goals, competencies and development plans and the Learning Object metadata updates the profile metadata; [0230] update existing objects).

**As per claims 3 and 12,** Mui discloses:

extracting, using the computing system, employee position management information in a third form that is associated with a second source computerized employee position management system that is distinct from the first source computerized employee position management system ([1209] the SABA interconnect backplane can access the new employee data via XML; [0857-858] accessor 935 and importer 940; Claim 19: job position profile record representing the person's job position, wherein the job position profile record identifies required competencies and associated required competency level; [0880] the AccessorReader is responsible for extracting the required object on the information passed in Local Object);

converting, using the computing system, the employee position management information in the third form into employee position management information that is in the second intermediate form ([0871-873] documents to be exchanged are defined, then XSL style sheets convert interchange format to the system specific XML format and vice versa; see also [1209] employee data via XML, the interconnect server performs style sheet transformation to convert the XML into the platform's native format and transmit the data to the business server which then updates the database management system; see also, [0737] the role of the view style is to convert the XML document to a format document understood by the user agent; see also [0857, 0893] the accessor 935 is used to extract objects from the source representation and convert them to a interchange format); and

Mui does not expressly disclose converting, using the computing system, the employee position management information in the second intermediate form into employee position management information in the target form.

However, Mui discloses wherein documents to be exchanged are defined, and where XSL style sheets then convert interchange format to the system specific XML format and vice versa [0871-873]. In addition, Peterson teaches a method for transferring information between first and second systems with dissimilar first and second database structures (col. 3, lines 15-29 method includes the step of first extracting data from the first system and then routing the extracted data from the first system to a first conversion server....at

Art Unit: 3629

the first conversion server data is converted from a format compatible with the first database structure to an intermediate format....the intermediate format is then routed to a second conversion server....at the second conversion server data is converted from the intermediate format to a format compatible with the second database structure....the data converted at the second conversion server is then stored in the second system). Petersen further teaches where at the first data conversion server, data is converted from a format compatible with the first database structure to an intermediate format, and where the data in the intermediate format is then routed to a second conversion server (second system). The Examiner interprets the second system to represent the target computerized employee position management system. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system and method for managing application processes disclosed by Mui to include the method and system for converting and routing the converted information as taught by Peterson in order to effectively convert and transmit employee position management information into a second intermediate form that corresponds to a target system so that the converted intermediate information may be stored in the target system.

Mui further discloses using the employee position management information in the target form to perform at least one computer-implemented act from a set of computer-implemented acts comprising:

creating a new employee position management record in the target computerized employee position management system ([0127] profile manager; [0230] the

Art Unit: 3629

persistence framework defines a common code path used to create new objects, restore and update existing objects, delete objects and find objects; [0234] creating a new employee; [1209] new employee is added and Claim 19: job position profile); and

updating an existing employee position management record in the target computerized employee position management system ([0004] constantly updating and advancing the skills and performance of the company's workforce; [0205-208] SABA performance manages profile metadata that describes individual and group goals, competencies and development plans and the Learning Object metadata updates the profile metadata; [0230] update existing objects).

**As per claims 5 and 14**, The Mui/Kurzius/Peterson combination disclose claims 1 and 10 as rejected above, where Mui further discloses a job type id, job title and requirements ([1241, 1245]) but does not expressly disclose wherein each of the plurality of employee position elements comprises one or more elements selected from a group comprising:

**a position identifier**; a position base data element; a position related division element; a position related organization element; and a position custom data element.

However, Kurzius teaches position titles, education, work history, and any other candidate qualification data can be listed in candidate records (col. 20, lines 41-48), and a job posting form that may be used by an employer to specify desired candidate

Art Unit: 3629

qualifications for a described employment position (col. 18, lines 54-67 & Fig. 18).

Lastly, Kurzius teaches job posting identifiers (col. 11, lines 12-15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the job type requirement of Mui to include job posting identifiers as taught by Kurzius in order to effectively identify and track the job position and the plurality of employee position elements within a job position.

Examiner notes, with respects to claims 6-9 and 15-18, which whom depend from claims 5 and 14, are rejected on the basis of the Examiners election of the employee position element: “a position identifier.”

**As per claims 6 and 15**, it recites equivalent limitations to claim 5 and 14 and are, therefore rejected using the same art and rationale as set forth above. In addition, claims 6 and 15 are directed to a non-elected employee position element: “a position base data element.”

**As per claims 7-9 and 16-18**, “wherein the position related division element includes a position related division identifier”, “wherein the position related organization element includes a position related organization identifier” and “wherein the related parent position element includes a related parent position identifier.”

The Examiner notes, as per claims 5 and 13 “wherein each of the plurality of employee position elements includes **one or more** elements...” The examiner elected “a position

identifier." Claims 7-9 and 16-18 are directed to the non-elected employee position elements: "the position related division element", "the position related organization element" and "the related parent position element." Accordingly, once the positively recited steps are satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios.

[See: *In re Johnston*, 77 USPQ2d 1788 (CA FC 2006); *Intel Corp. v. Int'l Trade Comm'n*, 20 USPQ2d 11 61 (Fed. Cir. 1991); MPEP 2106 II C].

Furthermore, with respect to claims 7-9: Mui discloses a job type id, job title and requirements [1241, 1245], however fails to disclose the specific position element categories. However the specific types of categories, is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The extracting, converting, creating and updating steps would be performed the same regardless of what type of categories they belong to. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

**As per claim 19**, Mui discloses a system, comprising:

a central processing unit (CPU) ([0220] business application platform system, where the general purpose system includes one or more central processing units);

a memory, coupled to the CPU, the memory (Fig. 2 Memory 211) further comprising:

Art Unit: 3629

a data structure *for* managing employee data, wherein the data structure comprises a list of employee position elements ([0003, 123] manage entities within a business, which includes employees, clients, companies, departments, and business units; see also [0268, 271, 292, 293, 330] data structure), stored in a second intermediate form *for* defining a hierarchy of data elements, the hierarchy of data elements comprises includes a plurality of employee position elements ([0871-873] documents to be exchanged are defined, then XSL style sheets convert interchange format to the system specific XML format and vice versa).

Mui does not expressly disclose:

“wherein the second intermediate form comprises a list of employee position elements for defining a hierarchy of data elements”, “the hierarchy of data elements comprises a plurality of employee position elements” and “the plurality of employee position elements comprises a related parent position element.”

However, Kurzius teaches wherein a web server receives candidate qualification data in a form of a candidate profile form. Parsing a particular candidate record may result in determination of eighteen candidate qualifications related to geography, technical qualifications, etc., and as a result of such parsing, eighteen candidate identifiers will be generated by candidate mapping engine for indexing and listing in map



categories of candidate map corresponding to the eighteen candidate qualifications (col. 5, line – col. 7, line 7; see Figs. 5, 14A-14B, 15 and the associated text). Kurzius also teaches wherein processor 86 may execute coded instructions that are stored in memory 88 on data that is also stored on memory 88 (col. 6, lines 1-17). In addition Kurzius teaches a filter engine operable to screen candidate profiles entered via a candidate survey form before storing such candidate profiles in candidate records within candidate record database. The candidate qualification data in a profile is evaluated to ascertain whether or not a predefined level of experience or competency is demonstrated by the candidate qualification data (col. 7, line 23 – col. 8, line 26). Kurzius further teaches a candidate matching engine operable to match candidate records to job posting records and wherein specific matching criteria may include required job criteria and preferred job criteria that is designated by an employer (col. 8, lines 27-40). Lastly, Kurzius teaches position titles, education, work history, and any other candidate qualification data can be listed in candidate records (col. 20, lines 41-48), and a job posting form that may be used by an employer to specify desired candidate qualifications for a described employment position (col. 18, lines 54-67 & Fig. 18).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method for enterprise workforce

planning disclosed by Mui to include a system and method for the management of candidate recruiting information as taught by Kurzius in order to effectively identify and evaluate the plurality of employee position elements linked to a parent position element so that the competencies identified in a candidate profile record are compared to the required competencies identified in a position in order to identify the best fit candidates.

The Mui/Kurzius combination does not expressly:

“instructions, stored in the memory *for* converting the employee position management information in the first form into employee position management information that is in the second intermediate form” and “instructions, stored in the memory, *for* converting the employee position management information in the second intermediate form into employee position management information in a target form that corresponds to a target computerized employee position management system.”

However, Mui discloses wherein documents to be exchanged are defined, and where XSL style sheets then convert interchange format to the system specific XML format and vice versa [0871-873]. Kurzius further teaches wherein a processor executes coded instructions that are stored in memory 88 on data that is also stored on memory 88 (col. 6, lines 1-17). In addition, Peterson teaches a

Art Unit: 3629

method for transferring information between first and second systems with dissimilar first and second database structures (col. 3, lines 15-29 method includes the step of first extracting data from the first system and then routing the extracted data from the first system to a first conversion server....at the first conversion server data is converted from a format compatible with the first database structure to an intermediate format....the intermediate format is then routed to a second conversion server....at the second conversion server data is converted from the intermediate format to a format compatible with the second database structure....the data converted at the second conversion server is then stored in the second system). Petersen further teaches where at the first data conversion server, data is converted from a format compatible with the first database structure to an intermediate format, and where the data in the intermediate format is then routed to a second conversion server (second system). The Examiner interprets the second system to represent the target computerized employee position management system. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system and method for managing application processes disclosed by Mui to include the method and system for converting and routing the converted information as taught by Peterson in order to effectively convert and transmit employee position management information into a second intermediate form that corresponds to a target system so that the converted intermediate information may be stored in the target system.

The Examiner notes, with respect to system claims 19-24. Mui discloses the CPU and the memory structure. Mui teaches various forms of data storage for it's system (i.e. disk storage unit 223 and CD-ROM medium [0220]). Furthermore, the specific use of the invention and/or any steps set forth in the claims are not given patentable weight. In fact, the claims do not recite any additional structural apparatus elements other than those discussed above. The other recitations of the claims recite various steps comprising a list of employee position elements. The patentability of an apparatus claim depends on the claimed structure, not on the use or purpose of that structure, *Catalina Marketing Int'l Inc. v. Coolsavings.com Inc.*, 289 F.3d 801, 809, 62 USPQ2d 1781, 1785 (Fed. Cir. 2002), or the function or result of that structure. *In re Danly*, 263 F.2d 844, 848, 120 USPQ 528, 531 (CCPA 1959); *In re Gardiner*, 171 F.2d 313, 315-16, 80 USPQ 99, 101 (CCPA 1948). It follows then that if a prior art apparatus possesses all of the claimed structural characteristics, including the capability of performing the claimed function, then there is a prima facie case of unpatentability. See *In re Ludtke*, 441 F.2d 660, 663-64, 169 USPQ 563, 566-67 (CCPA 1971). For this recitation and general proposition. See *Ex Parte Seaver et al.*

Furthermore, several claims are directed to nonfunctional descriptive material and are not functionally involved in the steps recited. This nonfunctional descriptive material *in a system claim is not given patentable weight*, and even when recited in a method claim, *will not distinguish the claimed invention from the prior art in terms of patentability* See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32

F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) and MPEP 2106.01. Applicant is directed to review this section of the MPEP when considering the limitations of any newly amended or drafted method claims.

Furthermore, a recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art- if the prior art has the capability to so perform. See MPEP 2114 and *Ex parte Masham*, 2 USPQ2d 1647 (1987). Please note this also applies to claims 20-24.

**As per claim 20**, Mui discloses a job type id, job title and requirements ([1241, 1245]) but does not expressly disclose wherein each of the plurality of employee position elements of the data structure comprises one or more fields representing elements selected from a group comprising:

**a position identifier**; a position base data element; a position related division element; a position related organization element; and a position custom data element.

However, Kurzius teaches position titles, education, work history, and any other candidate qualification data can be listed in candidate records (col. 20, lines 41-48), and a job posting form that may be used by an employer to specify desired candidate qualifications for a described employment position (col. 18, lines 54-67 & Fig. 18).

Lastly, Kurzius teaches job posting identifiers (col. 11, lines 12-15).

Art Unit: 3629

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the job type requirement of Mui to include job posting identifier as taught by Kurzius in order to effectively identify and track the job position and the plurality of employee position elements within a job position.

Examiner notes, with respects to claims 21-24, which whom depend from claim 20, are rejected on the basis of the Examiners election of the employee position element: “a position identifier.”

**As per claim 21**, it recites equivalent limitations to claim 20 and is, therefore rejected using the same art and rationale as set forth above. In addition, claim 21 is directed to a non-elected employee position element: “a position base data element.”

**As per claims 22-24**, “wherein the position related division element of the data structure comprises a data item configured to identify a position related division”, “wherein the position related organization element of the data structure comprises a data item configured to identify a position related organization” and “wherein the related parent position element of the data structure comprises a data item configured to identify a related parent position.”

The Examiner notes, as per claim 20 “wherein each of the plurality of employee position elements of the data structure comprises one or more fields representing elements....”

The Examiner elected “a position identifier.” Claims 22-24 are directed to the non-elected employee position elements: “the position related division element”, “the position related

Art Unit: 3629

organization element” and “the related parent position element.” Accordingly, once the positively recited steps are satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios. [See: *In re Johnston*, 77 USPQ2d 1788 (CA FC 2006); *Intel Corp. v. Int'l Trade Comm'n*, 20 USPQ2d 11 61 (Fed. Cir. 1991); MPEP 2106 II C].

**Please note:**

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

a. **“*For*”**

See *e.g. In re Collier*, 158 USPQ 266, 267 (CCPA 1968)(where the court interpreted the claimed phrase “a connector member for engaging shield means” and held that the shield means was not a positive element of the claim since “[t]here is no positive inclusion of ‘shield means’ in what is apparently intended to be a claim to structure consisting of a combination of elements.”

b. **“*-Able*”**

See *e.g. In re Collier*, 158 USPQ 266, 267-68 (CCPA 1968)(where the court interpreted the claimed phrase “said ferrule-forming member being crimpable onto said shield means” and held that the shield means was not a positive element of the claim since “[t]here is no positive inclusion of ‘shield means’ in what is apparently intended to be a claim to structure consisting of a combination of elements.... “[t]he ferrule or connector member is crimpable but not required,

Art Unit: 3629

structurally, to be crimped .... These cannot be regarded as structural limitations and therefore not as positive limitations in a claim directed to structure. They cannot therefore be relied on to distinguish from the prior art.”)

Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See *e.g.* MPEP §2106 II C: “Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]”; and *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006) “As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.” *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006)(where the Federal Circuit affirmed the Board’s claim construction of “further including that said wall may be smooth, corrugated, or profiled with increased dimensional proportions as pipe size is increased” since “this additional content did not narrow the scope of the claim because these limitations are stated in the permissive form ‘may.’”).

### **Response to Argument**

Applicant's arguments filed 5/20/2009 have been fully considered but they are not persuasive. In the remarks the Applicant(s) argues:

#### **Claim 19 (amended)**

(1) To the extent that the Office Action's arguments may be applied against the amended claims, Applicants respectfully submit that the present Office Action does not articulate a



Art Unit: 3629

prima facie case of anticipation by Mui, because the Office Action does not allege the presence in Mui of certain recited elements of Applicants' amended claim 19. This amendment provides specific functional matter for performing the function of "converting the employee position management information in the second intermediate form into employee position management information in a target form that corresponds to a target computerized employee position management system." Applicants further respectfully submit that arguments provided, below, with respect to the patentability of independent Claim 1 over the combination of Mui and Peterson (and Kurzius (cited in full below)) apply with equal force to the patentability of the limitations now recited by Claim 19. For at least this reason, Applicants respectfully submit that independent amended Claim 19 is patentable over the combination of Mui and Peterson (and Kurzius).

In response to argument (1), the Examiner has fully considered the argument but it's not persuasive. Based on the new grounds of rejection argument (1) is moot.

**Claim 1 (amended)**

(2) Applicants respectfully submit that the present Office Action does not articulate a prima facie case of obviousness over the alleged combination of Peterson with Mui (or with Kurzius), because the purported combination does not teach or suggest all of the recited limitations of independent amended Claims 1 and 10, which are rejected under similar reasoning. Specifically, Applicants respectfully submit that the combination of Mui with Peterson does not teach or suggest at least "the plurality of employee position elements includes a related parent position element" limitation. For at least this reason,

Art Unit: 3629

the combination of Mui with Peterson fails to teach or suggest all of the claim limitations recited in amended Claims 1 and 10. The amended limitation that "the plurality of employee position elements includes a related parent position element" has been incorporated into amended independent Claim 1 from a previous version of dependent Claim 5. Applicants respectfully submit that the cited sections (citing Kurzius, Col. 11, 11 12-15, Col. 18, 11 54-67 and Col. 20, 11 41-48) merely disclose the purported attributes of a candidate rather than those of a position or an organization. Such candidate attributes fail to provide teaching or suggestion the claimed "related parent position element" limitation. This is because a parent position element requires a relationship between the position other positions within a hierarchy, which one skilled in the art would not logically expect to see (and which is certainly not taught or suggested) in a job listing disclosed by the cited sections of Kurzius. For at least this reason, Applicants respectfully submit that the combination of Peterson, Mui and Kurzius fails to provide disclosure of all the limitations of independent Claims 1 and 10, as amended, and all claims depending therefrom, and that these claims are in condition for allowance. Similarly, as discussed above, independent Claim 19 has been amended to incorporate similar limitations to those discussed with respect to Claims 1 and 10. For the reasons discussed herein, Applicants submit that independent Claim 19, as amended, and all claims depending therefrom are in condition for allowance.

In response to argument (2), the Examiner has fully considered the argument but it's not persuasive. Based on the new grounds of rejection, argument (2) is moot. The Examiner notes a test of obviousness is not whether features of a secondary reference

Art Unit: 3629

may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested in any one or all of references, rather, test is what combined teachings of references would have suggested to those of ordinary skill in the art. *In re Keller*, 208 USPQ 871 (CCPA 1981).

### ***Conclusion***

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Patent application number: 10/162,446 invented by Stimac recites: "System and method for screening of job applicant."

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 3629

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BOB CHUMPITAZ whose telephone number is (571)270-5494. The examiner can normally be reached on M-TR: 7:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN WEISS can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-270-6494.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

B. C.  
Examiner, Art Unit 3629

/JOHN G. WEISS/

Application/Control Number: 10/751,011

Page 28

Art Unit: 3629

Supervisory Patent Examiner, Art Unit 3629